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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANT: Peter Fajkowski

SERIAL NO.: ⁰⁹~~29~~/297,532

DOCKET NO.: 8958.004

FILED: June 28, 1999

ART UNIT: 2876

EXAMINER: St. Cry, D.

TITLE: Method & Apparatus for Coupon Management & Redemption

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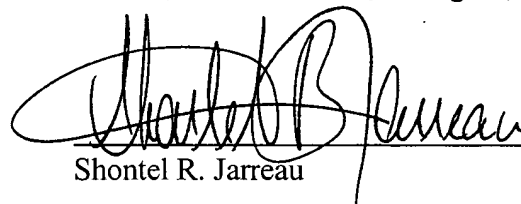
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09 22/297,532	
	Filing Date	June 28, 1999	
	First Named Inventor	Peter Fajkowski	
	Group Art Unit	2876	
	Examiner Name	St. Cry, D.	
Total Number of Pages in This Submission	3	Attorney Docket Number	8958.004

ENCLOSURES *(check all that apply)*

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers <i>(for an Application)</i> <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i> Appendix (2 pages) and Transmittal Form
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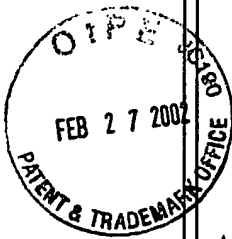
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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

APPLICANT: Peter W. Fajkowski TITLE: Method and Apparatus for Coupon
Management and Redemption
SERIAL NO.: 09/297,532 ART UNIT: 2876
FILING DATE: June 28, 1999 EXAMINER: St. Cyr, D.
DOCKET NO.: 8958.004

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Revised Brief in Support of Appeal

The Honorable Commissioner of
Patents and Trademarks
Box Patent Appeals
P.O. Box 2327
Arlington, VA 22202

Dear Sir:

This revised brief is filed pursuant to the office action mailed on January 28, 2002, in which the examiner objected to several informalities in the original brief. The applicant was required to submit a revised brief within one month, with the informalities corrected. This brief is believed to be timely filed. However, if any additional extension is required, please consider this a request therefor. No additional fees are believed to be due at this time; however, if any are due the Commissioner is authorized and respectfully requested to charge the same to deposit account no. 18-2210.

The examiner's rejections are respectfully traversed, and the Board is respectfully requested to reverse the examiner's rejections of the applicant's claims for the reasons detailed below.

I. Real Party in Interest

The real party in interest is Peter W. Fajkowski.

II. Related Appeals and Interferences

None.

III. Status of Claims

Claims 1-24 Canceled by preliminary amendment

Claim 25 Rejected

Claims 26-41 Canceled by preliminary amendment

Claim 42-47 Rejected

Claim 48 Rejected in non-final action and not addressed in final action

Claims 49-53 Rejected

IV. Status of Amendments

No amendments have been filed subsequent to the entry of the final office action.

V. Summary of the Invention

There are four separate independent claims at issue in this appeal. The preferred embodiment of the invention to which claim 25 is directed involves a method of broadcasting radio signals comprising electronic coupon data. In the method, it is first determined what coupon data will be broadcast. Next, a radio signal containing the selected data is modified so that a specific storage device, such as coupon card 1, can receive it. Finally, the modified signal is broadcast to the specific storage device. The preferred embodiment of this method is described on page 43 of the specification, starting at line 4.

The preferred embodiment of the invention to which claim 43 is directed is an adapter 350 for converting recorded data on a disk to electrical data for wireless transmission to a storage device such as coupon card 1. The adapter 350 has a body 358 appropriately sized to fit in a disk

drive 360. The body 358 has an insertion port 354 for receiving the storage device and a memory 352 for receiving the recorded data. There is also a wireless transmitter on the body 358 for receiving and transmitting the electrical data in a wireless signal. Finally, the body 358 contains a processor 353 for converting the recorded data into electrical data so that it can be transmitted by the wireless transmitter. The preferred embodiment of the adapter 350 is described in the specification starting on page 39 at line 26 and is illustrated in figures 19a and 19b.

The preferred embodiment of the invention to which claim 46 is drawn is an apparatus for telephonically distributing electronic coupon data to a coupon storage device, such as coupon card 1. The apparatus has a port 405 sized to receive a coupon storage device. It also has a modem 416 for telephonically receiving electronic coupon data and a microprocessor 425 controlling the receipt and transfer of the coupon data. The apparatus also has a random access memory 417 that interacts with the microprocessor 425 and a telephonic subcomponent that includes a telephone keypad 401. The preferred embodiment of this invention is described in the specification starting on page 41 at line 18 and is illustrated in figures 20a and 20b.

Finally, the preferred embodiment of the invention to which claim 53 is drawn is a system for transferring coupon data from a computer to an electronic coupon card 1. The electronic coupon card 1 has a microprocessor 25 and circuitry for receiving and storing coupons as well as receiving elements, such as communications port 14. The system also includes an adapter 350 that has three parts: an adapter body 358; a reader, such as magnetic head 357; and a processor 353. The adapter body 358 has transmitting elements and is configured to align the receiving elements of the coupon card with the transmitting elements of the adapter body 358 so that they can communicate with each other. The reader is operatively connected to the adapter body 358. It

allows the adapter 350 to receive coupon data from an outside computer. Finally, the processor 353 receives coupon data from the reader and transfers the coupon data to the coupon card 1 where it is stored. A description of the preferred embodiment of the adapter 350 can be found in the specification at page 39 beginning at line 26 and is illustrated in figures 19a and 19b. A description of the preferred embodiment of the coupon card 1 can found in the specification at page 10 beginning at line 22 and is illustrated in figures 1-6.

VI. Issues

1. Whether the examiner has established a *prima facie* case that claims 25 and 42 are obvious under 35 U.S.C. § 103 in view of U.S. Patent 5,424,524.
2. Whether U.S. Patent 5,663,553 anticipates claims 43 and 44 under 35 U.S.C. § 102(e).
3. Whether the examiner has established a *prima facie* case that claims 46-52 are obvious under 35 U.S.C. § 103 over U.S. Patent 5,250,789 in view of U.S. Patent 5,663,553.
4. Whether the examiner has established a *prima facie* case that claim 53 is obvious under 35 U.S.C. § 103 over U.S. Patent 5,250,789 in view of U.S. Patent 5,663,553.

VII. Grouping of the Claims

The claims may be properly grouped as follows:

1. Claims 25 and 42. These claims do not rise or fall with any other claims.
2. Claims 43-45. These claims do not rise or fall with any other claims.
3. Claims 46-52. These claims do not rise or fall with any other claims.
4. Claim 53. This claim does not rise or fall with any other claim.

VIII. Argument

A. The Examiner's Objections to the Informalities

The examiner's objections to the claim language is acceded to. The applicant respectfully requests that the examiner enter an examiner's amendment corresponding to the requirements set out on page 1 of the April 17, 2001, office action or that the case be remanded to the examiner to allow the applicant to submit the appropriate amendments, after the Board addresses the merits of the appealed rejections.

B. Claims 25, 42

Claim 25 is an independent claim. It is set out below:

25. A method for the radio broadcast of electronic coupon data to a specific storage device comprising the steps of:

- a. predetermining what coupon data will be broadcast to a specific storage device; and
- b. broadcasting a signal carrying said coupon data wherein said signal is modified to be receivable by said specific storage device.

Claim 42 is dependent upon claim 25. It is set out below:

42. A method according to claim 25, further comprising the step of receiving and recording said radio broadcast with a storage device having a radio receiver.

The examiner has rejected claims 25 and 42 in view of U.S. Patent 5,424,524 to Ruppert *et al.* ("Ruppert"). To establish his *prima facie* case of obviousness under § 103 the examiner must establish that the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP §§ 706.02 (j); 2143.03. As the examiner has conceded, Ruppert does not teach or suggest the use of radio broadcast for transmitting the coupon data. April 17, 2001. Office Action, Page 3.

In rejecting claims 25 and 42, the examiner contends that the infrared transceiver disclosed in Ruppert is an "alternate and functional equivalent communication means" to radio transmission.

This is hardly the case. Radio transmission is capable of communication across much greater distances than those suitable for infrared transmissions. However, for the present purposes, what is important is that the examiner has not made any showing that radio transmission and infrared transmissions are recognized as equivalents in the prior art. Such a showing is required in order to establish a *prima facie* case of obviousness based on the substitution of one alleged equivalent for another. MPEP § 2144.06.

Rather than make such a showing, the examiner has relied upon the applicant's disclosure. As a legal matter, this is improper. MPEP § 2144.06. As a factual matter it is simply incorrect. In arguing that the applicant teaches that radio transmission and infrared transmission are equivalent, the examiner cites page 12 of the specification. While that portion of the specification references infrared transceiver devices as potential substitutes for magnetic disk writing or laser transmit-receive devices such as those used with CD ROM devices, radio transmission devices are not mentioned at all. Rather, the specification addresses radio transmission in an entirely different context on page 43. There, the specification discusses the use of radio transmissions as a substitute for the use of telephone lines to communicate with remote database 410. Nowhere in the specification does the applicant suggest that infrared transmissions would be acceptable for this task, and the examiner is in error to the extent that he suggests otherwise.

The examiner also argues that "being functionally equivalent is to perform *similar function*." (April 17, 2001, Office Action, p. 4, emphasis added). This is simply not correct. The examiner must show that the equivalency is recognized in the prior art. MPEP § 2144.06. "The mere fact that components are *functional or mechanical equivalents*" is not sufficient to establish equivalency. MPEP § 2144.06 (emphasis added). Thus, even if infrared data transmission was

functionally similar to radio data transmission, as the examiner alleges, that would not establish that the two are equivalents for purposes of § 103.

In view of the foregoing, the examiner has clearly not established that sending data via infrared transmission is recognized by the prior art as an equivalent of sending data via radio signals, and accordingly, has not established his *prima facie* case with respect to claims 25 and 42. Therefore, the rejection should be withdrawn and an early notice of allowability is respectfully requested for those claims.

C. Claims 43-45

Claim 43 is independent. Claims 44 and 45 depend from 43. Claim 43 is set out below.

43. An adapter for converting recorded data on a disk device to electrical data for wireless transmission of the contents of said recorded data to a storage device, said adapter comprising:

- a. an adapter body sized to be inserted in a disk drive;
- b. an insertion port formed on said body for receiving said storage device;
- c. a memory on said body for receiving the contents of said recorded data;
- e. a wireless transmitter on said body for receiving electrical data and transmitting said electrical data in a wireless signal; and
- f. a processor on said body for converting the contents of said recorded data into electrical data which may be transmitted through said wireless transmitter.

Claims 43 and 44 have been rejected under 35 U.S.C. § 102(e) in view of U.S. Patent 5,663,553 to Aucsmith ("Aucsmith"). Aucsmith discloses a device for transmitting data between a "smart card" and a data processing machine. The preferred embodiment is essentially a carrier shaped like a 3½" floppy disk. The carrier is sized to receive a smart card. The carrier can read and store the information on the smart card. When the carrier is inserted into the 3½" floppy disk of a personal computer, for example, the carrier transmits the data received from the smart card to

the PC. The methods disclosed in Aucsmith for allowing the smart card to communicate with the carrier or the carrier to communicate with the PC or other data processing unit are:

- 1) frictional contact between card contact pads 328 to close an electrical circuit; and
- 2) a magnetic coil connected to a magnetic transducer.

See, Aucsmith Col. 4, ll. 34-46; Col. 4, ln. 62 - Col. 5, ln. 5; Col. 5, ll. 32-42; Col. 6, ll. 31-53.

Both of the means of data transmission disclosed in Aucsmith require either immediate contact between the sending and receiving units or, in the context of the magnetic coil and transducer, a separation that is vanishingly small. Neither of these data transmission means would satisfy the limitation in claim 42 requiring a “*wireless* transmitter for receiving electrical data and transmitting said electrical data in a *wireless* signal,” as such a limitation clearly requires the transmitter be able to transmit and receive signals over a distance, as by radio or other EMF signals.

A reference cannot anticipate a claim under § 102 if even one limitation is not found in the reference. MPEP § 2131. Aucsmith does not disclose a wireless transmitter for receiving electrical data and transmitting said electrical data in a wireless signal. Therefore, Aucsmith does not properly anticipate claim 43. No other rejection has been entered against claim 43. Accordingly, claim 43 should be allowed. Likewise, claims 44-45, which depend upon claims 43, should be allowable as well.

C. Claims 46-52 and 53

Claim 46 is an independent claim. It is reproduced below.

46. An apparatus for the telephonic distribution of electronic coupon data to a storage device, said apparatus comprising:

- a. an insertion port for receiving a coupon storage device;

- b. a modem for telephonically receiving electronic coupon data;
- c. a microprocessor controlling the receipt and transfer of electronic coupon data;
- d. a random access memory interacting with said microprocessor; and
- e. a telephonic subcomponent including a telephone keypad.

Claims 47 through 52 depend on claim 46.

Claim 53 is an independent claim. It is reproduced below.

53. A system combining an electronic coupon card with an adapter for transferring coupon data from another computer to said coupon card, said system comprising:

- a. an electronic coupon card having a microprocessor and circuitry for receiving and storing coupons;
- b. an adapter having:
 - i. an adapter body configured to receive and align receiving elements of said coupon card with transmitting elements of said adapter body;
 - ii. a reader operatively connected to said adapter body and allowing said adapter to receive coupon data from another computer; and
 - iii. a processor for receiving coupon data from said reader and transferring said coupon data to said coupon card for storage thereon.

The examiner has rejected claims 46 and 53 as being obvious under § 103 over U.S. Patent 5,250,789 to Johnson ("Johnson") in view of 5,663,553 to Aucsmith ("Aucsmith"). To establish a *prima facie* case of obviousness based upon the combination of two or more references, the examiner must establish first that there is a motivation to combine the references and second that the combined references teach or suggest all of the limitations of the claims. MPEP §§ 2143.01, 2143.03. The teaching or suggestion to make the combination must be found in the prior art and not the applicant's disclosure. MPEP § 2142. Additionally, if the proposed modification would render the prior art device being modified unsatisfactory for its intended purpose, there is no suggestion to make the proposed modification. MPEP § 2143.01

The examiner has not shown a basis for combining Aucsmith and Johnson. In an effort to establish a basis for combining Aucsmith and Johnson the examiner has stated only:

In view of the disclosure of Aucsmith above, it would have been obvious to employ the device of Aucsmith into the system of Johnson so that shoppers can securely personalizing (sic) their shopping list into smart cards before going to market. Such modification would (sic) convenient and reliable.

April 17, 2001, Office Action, p. 3.

Johnson is configured to read data on a floppy disk. Johnson, Col. 5, ll. 60-64. There is no mention in Johnson anywhere of smart cards or smart card compatibility. If a shopper “personalized his shopping list onto a smart card” as the examiner suggests, the device of Johnson would not be able to read it when the shopper arrived at the store. Moreover, the examiner has provided no citation to anything *in the prior art* which would suggest why a shopper using the Johnson device would want to “personalize their shopping list onto a smart card” or what benefit would be derived from doing so. In the absence of such a showing the examiner has provided no basis for combining the references and has, therefore, not met his *prima facie* burden with respect to these claims.

Even if the combination of Aucsmith and Johnson were suggested in the prior art, the combination would not teach or suggest every limitation in claim 46. Claim 46 requires the claimed apparatus to contain a “a modem for telephonically receiving electronic coupon data.” This is a functional limitation specifically requiring that the modem be configured to receive electronic coupon data. Johnson discloses a modem; however, the only function disclosed for the modem in Johnson is to receive shopping lists from customers. Johnson, Col. 7, ll. 22-29. Nowhere in Johnson is there any disclosure regarding the use of a modem to send or receive coupon data. Aucsmith does not disclose coupon data or a modem. Thus, when the two references

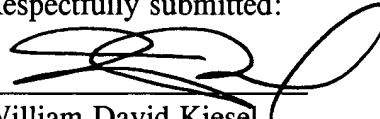
are combined, they do not teach or suggest the functional limitation that the modem be configured to receive coupon data. Therefore, the references do not teach or suggest all of the limitations of claim 46, even if they are combined, and the examiner has not met his *prima facie* case with respect to claim 46 and the claims that depend therefrom.

Claim 53 requires "an electronic coupon card having a microprocessor and circuitry for receiving and storing coupons." Aucsmith discloses an electronic card having a microprocessor and circuitry; however, nothing in Aucsmith or Johnson suggests modifying either the microprocessor or the circuitry to receive or store coupons. More importantly, the examiner has not explained what in the prior art suggests such a modification. Therefore, the examiner has not met his *prima facie* case with respect to claim 53.

In view of the foregoing, all of the claims remaining in the application are believed to be patentable over the art of record and an early notice of allowability is respectfully requested.

Dated: February 27, 2002

Respectfully submitted:



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Registration No. 25,883

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Appendix

25. A method for the radio broadcast of electronic coupon data to a specific storage device comprising the steps of:

- a. predetermining what coupon data will be broadcast to a specific storage device; and
- b. broadcasting a signal carrying said coupon data wherein said signal is modified to be receivable by said specific storage device.

42. A method according to claim 25, further comprising the step of receiving and recording said radio broadcast with a storage device having a radio receiver.

43. An adapter for converting recorded data on a disk device to electrical data for wireless transmission of the contents of said recorded data to a storage device, said adapter comprising:

- a. an adapter body sized to be inserted in a disk drive;
- b. an insertion port formed on said body for receiving said storage device;
- c. a memory on said body for receiving the contents of said recorded data;
- e. a wireless transmitter on said body for receiving electrical data and transmitting said electrical data in a wireless signal; and
- f. a processor on said body for converting the contents of said recorded data into electrical data which may be transmitted through said wireless transmitter.

44. An adapter according to claim 43, wherein said reader head is a magnetic reader head.

45. An adapter according to claim 44 wherein said wireless transmitter includes a light emitting diode and a light responsive transistor.

46. An apparatus for the telephonic distribution of electronic coupon data to a storage device, said apparatus comprising:

- a. an insertion port for receiving a coupon storage device;
- b. a modem for telephonically receiving electronic coupon data;
- c. a microprocessor controlling the receipt and transfer of electronic coupon data;
- d. a random access memory interacting with said microprocessor; and
- e. a telephonic subcomponent including a telephone keypad.

47. An apparatus according to claim 46, further comprising a light emitting diode and a light responsive transistor positioned in luminous connection with said storage device when said storage device is positioned in said insertion port.

48. An apparatus according to claim 47, further comprising a telephone subcomponent.
49. An apparatus according to claim 48, wherein said telephone subcomponent includes a telephone keypad and a speaker.
50. An apparatus according to claim 46 further comprising a display screen
51. An apparatus according to claim 46 further comprising a bar code reader.
52. An apparatus according to claim 46, further comprising keys allowing a user to review a list of coupons and select individual coupons from said list.
53. A system combining an electronic coupon card with an adapter for transferring coupon data from another computer to said coupon card, said system comprising:
- a. an electronic coupon card having a microprocessor and circuitry for receiving and storing coupons;
 - b. an adapter having:
 - i. an adapter body configured to receive and align receiving elements of said coupon card with transmitting elements of said adapter body;
 - ii. a reader operatively connected to said adapter body and allowing said adapter to receive coupon data from another computer; and
 - iii. a processor for receiving coupon data from said reader and transferring said coupon data to said coupon card for storage thereon.